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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,190	11/17/2000	Xiaoan Hou	196033US28	5420

22850 7590 12/29/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/714,190

**Applicant(s)**

HOU, XIAOAN

**Examiner**

CHAN S PARK

**Art Unit**

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-11,14-17 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-11, 14-17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 8/20/04, and has been entered and made of record. Currently, **claims 1, 2, 5-11, 14-17 and 20-23** are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to **claims 1, 2, 5-11, 14-17 and 20-23** have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 8, 9, 11, 14-17, 20, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al. U.S. Patent No. 6,330,070 (hereinafter Toyoda) in view of Reifman et al. U.S. Patent No. 5,917,615.

3. With respect to claim 1, Toyoda teaches a method of transmitting a facsimile, comprising:

creating an image (data sent by email in col. 2, lines 57-58);

inputting parameters of a fax machine (IFAX 14) from a general purpose computer (PC 12), the parameters including a password of the fax machine (col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57);

forming an electronic mail address that includes an Internet electronic mail address of the fax machine, the input password of the fax machine, and a fax number of a second fax machine (col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57);

generating a fax request as an electronic mail message, the electronic mail message including the electronic mail address and the image (col. 2, lines 57-64); and

transmitting the electronic mail message to the fax machine (col. 2, lines 57-64).

Toyoda, however, does not teach expressly that the parameters of the fax machine are inputted to a *graphical user interface* of a general purpose computer.

Reifman teaches a method for transmitting a facsimile, comprising the steps of: creating an image (col. 21, lines 33-63 & fig. 16);

inputting parameters of a fax machine to a graphical user interface of a general purpose computer (figs. 6-10); and

transmitting the image to the fax machine (fig. 11).

Toyoda and Reifman are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the graphical user interface of Reifman into the Internet relay facsimile of Toyoda.

The suggestion/motivation for doing so would have been to provide a more user friendly and convenient interface setting as it is widely used in a multifunctional image processing peripheral.

Therefore, it would have been obvious to combine Toyoda with Reifman to obtain the invention as specified in claim 1.

4. With respect to claim 2, Toyoda teaches the method further comprising:  
receiving the electronic mail message by the fax machine (col. 2, lines 59-64);  
analyzing the electronic mail message to determine the fax number of the second fax machine (col. 5, lines 5-26); and

transferring the image form the fax machine to the fax number of the second fax machine (col. 5, lines 21-26).

5. With respect to claim 5, Toyoda teaches the method wherein the transmitting step comprises: transmitting the electronic mail message to the fax machine through the Internet (fig. 1).

6. With respect to claim 6, Reifman teaches a step of selecting the image from a list of images (figs. 13 & 14).

7. With respect to claim 8, Toyoda discloses a computer program product including a computer readable medium for transmitting a facsimile, comprising:

an image creating code configured to create an image to be transmitted through the Internet (data sent by email in col. 2, lines 57-58);

a parameter inputting code configured to input parameters of a fax machine to which the image will be transmitted, the parameters including a password of the fax machine (col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57); and

a fax request generating code configured to generate a fax request as an electronic mail message including the image and to send the fax request to the fax machine, the electronic mail message comprising an Internet electronic mail address of the fax machine, the password of the fax machine, a fax number of a second fax machine, and the image to be faxed (col. 2, lines 57-58; col. 3, lines 59-62; col. 4, lines 54-58; and col. 5, lines 53-57).

Toyoda does not disclose expressly a graphical user interface configured to allow a user to input parameter of a fax machine to which the image will be transmitted.

Reifman discloses a computer program product including a computer readable medium for transmitting a facsimile including a graphical user interface configured to allow a user to input parameter of a fax machine to which the image will be transmitted (figs. 6-10).

Toyoda and Reifman are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the graphical user interface of Reifman into the Internet facsimile of Toyoda.

The suggestion/motivation for doing so would have been to provide a more user friendly and convenient interface setting as it is widely used in a multifunctional image processing peripheral.

Therefore, it would have been obvious to combine Toyoda with Reifman to obtain the invention as specified in claim 8.

8. With respect to claim 9, Reifman discloses the computer program product further comprising an image selecting code configured to allow the user to select the image from a list of images (figs. 13 & 14).

9. With respect to claim 11, the combination Toyoda and Reifman discloses the graphical user interface comprises:

a control window configured to input parameters of the fax machine (col. 5, lines 53-57 of Toyoda and figs. 6-10 of Reifman);

a setting window configured to input the parameters of the fax machine and mail parameters in order to generate a fax request as an electronic mail message (col. 2, lines 50-64 of Toyoda); and

a print window configured to select a driver to create an image (figs. 24, 25, 80-83 & 94 of Reifman).

10. With respect to claim 14, Toyoda discloses the computer program wherein the image is printed at the fax machine (S705 in fig. 7).

11. With respect to claim 15, Toyoda discloses the computer program wherein the image is printed at the second fax machine (col. 5, lines 25-26). It is assumed that the

second fax machine has a printing capability to print the received facsimile data since any conventional fax machine has that capability.

12. With respect to claim 16, arguments analogous to those presented for claims 1 and 8, are applicable.

13. With respect to claim 17, arguments analogous to those presented for claim 2, are applicable.

14. With respect to claim 20, arguments analogous to those presented for claim 5, are applicable.

15. With respect to claim 21, arguments analogous to those presented for claim 6, are applicable.

16. With respect to claim 23, arguments analogous to those presented for claims 1 and 11, are applicable.

17. With respect to claim 24, Reifman discloses the graphical user interface wherein the fax parameters comprise fax document information (fig. 82), receiver information (fig. 6), and sender information (fig. 38).

Claims 7, 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Toyoda and Reifman as applied to claims 1, 8 and 22 above, and further in view of Yashiki U.S. Patent No. 6,512,593.

18. With respect to claim 7, the combination of Toyoda and Reifman teaches the method of claim 1, but it does not teaches expressly a method of creating the image in TIFF format.



Yashiki, the same field of endeavor of the Internet facsimile, teaches the method of creating an image in TIFF format for email transmission.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to utilize the TIFF format taught by Yashiki in the Internet facsimile system of Toyoda and Reifman.

The suggestion/motivation for doing so would have been to convert and transmit the facsimile image data in TIFF format in the Internet.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 7.

19. With respect to claims 10 and 22, arguments analogous to those presented for claim 7, are applicable.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

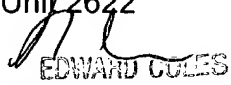
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
December 21, 2004

Chan S. Park  
Examiner  
Art Unit 2622

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNICAL